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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,687	03/25/2004	Daniel H. Kim	3518.1014-000	6068

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EXAMINER

PHILOGENE, PEDRO

ART UNIT PAPER NUMBER

3733

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,687

Applicant(s)

KIM, DANIEL H.

Examiner

Pedro Philogene

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 30-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/25/04, 8/23/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-29, drawn to a surgical retractor, classified in class 600, subclass 232.
- II. Claims 30-37, drawn to a retractor blade assembly, classified in class 600, subclass 223.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the surgical retractor does not require a fixed rack and the retractor blades suspended from the rack. The subcombination has separate utility such as vaginal speculum.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Scott pierce on 8/17/06 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-29. Affirmation of this election must be made by applicant in replying to this Office action.

Claim 30-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 14-17, 27, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Deckman et al. (5,984,867).

With respect to claim 1, Deckman et al disclose a surgical retractor positioning device (10), comprising a frame (22) an arm (56,58) connected to the frame, the arm including a proximal end and a distal end having a distal end axis, and a major axis, the distal end axis being movable relative to the proximal end, whereby the distal end axis can intersect the major axis at an angle, as best seen FIGS.1-4, and at least one blade (32) connected to the distal end of the arm, the blade being fixably rotatable about the major axis; as best seen in FIGs.1-4, and as set forth in column 3, lines 12-67, column 4, lines 50.

With respect to claims 2-6, 14-17, Deckman et al disclose a surgical retractor with at least two arms, wherein at least one arm is movable relative to the frame and further including a blade connected to the distal end of the second arm, and further including an assembly device including a rack (54,74) to facilitate positioning the blades

onto the arms, the blades being suspended from the rack at the proximal end; as best seen in FIGS.1-4, and as set forth in column 3, lines 12-67, column 4, lines 1-50.

With respect to claims 27,29, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-13,24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deckman et al. (5,984,867) in view of Gauthier (4,010,741).

With respect to claims 7-13, 24-26, it is noted that Deckman et al disclose all the limitations, except for the arms being collinear and a circular frame; as claimed by applicant. However, in a similar art, Gauthier evidence the use of a circular frame and at least four arms with major axis that are collinear or intersect thereby creating a bigger cavity.

Therefore, given the teaching of Gauthier, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Deckman et al, as taught by Gauthier, to create a bigger cavity.

Claims 18-23,28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deckman et al. (5,984,867) in view of Salvestro et al. (5,020,933).

With respect to the above claims, it is noted that Deckman et al teach all the limitations, except for a pressure/position sensor and a controller; as claimed by applicant. However, in a similar art, Salvestro et al evidence the use of a retractor with pressure/position sensor and a controller for sensing tissue retraction pressure, for controlling the position of the retractor blade.

Therefore, given the teaching of Salvestro, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Deckmann et al, as taught by Salvestro for sensing tissue retraction pressure and controlling the position of the retractor blade.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,125,396	06-1992	Ray
4,254,763	03-1981	McCready et al.
3,998,217	12-1976	Trumbull et al.
1,839,726	01-1932	Arnold

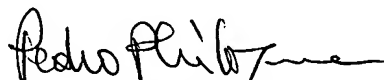
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
August 18, 2006


PEDRO PHILOGENE
PRIMARY EXAMINER